

REMARKS/ARGUMENTS

Claims 1-9 are pending, and all claims have been finally rejected for both Double Patenting and obviousness under 35 U.S.C. § 103. Re-examination and reconsideration of the claims in view of the following remarks are respectfully requested.

A Terminal Disclaimer over commonly owned U.S. Patent No. 6,702,782 is provided. Thus, the Double Patenting rejection has been overcome.

Applicants respectfully disagree with the obviousness rejections for the reasons set forth below.

Claims 1, 2, 6, and 7 were rejected as being obvious over the combination of U.S. Patent No. 6,213,995 to Steen et al. in combination with U.S. Patent No. 5,052,105 to Mische et al.

While Applicants generally agree with the Examiner's characterization of Steen, they respectfully disagree that it would have been obvious to one skilled in the art to combine the teachings of Steen with those of Mische et al. Mische et al. describes method and structure for producing electrical interconnect cables. While Mische does describe that hollow tube 19 may be used in such electrical interconnect cables, there is no teaching or suggestion in Mische which would lead one skilled in the art to substitute such hollow conductors for the solid core reinforcement elements of Steen. In particular, it is noted that Mische teaches solid cable structures which may have both hollow and solid-core conductors embedded therein. See, e.g., Fig. 12. Mische does not teach that the conductors would be braided, (although in Fig. 11 they appear to be twisted) and there is certainly no suggestion of putting such electrical conductors into the wall of a polymeric tubular member of a catheter body, as required by all claims in the present application.

As is well known to the Examiner, obviousness requires not only that each and every element of the claimed combination be present in the prior art, but also that there be some suggestion or motivation present in the prior art or within the general knowledge of one of ordinary skill in the art to make the necessary combination. See, MPEP § 2143.

The Examiner argues that such motivation is found in this case since Mische teaches that hollow conductors may be substituted for solid core conductors, where the solid core conductors provide "another means to transport something from one end of the catheter to the other which would expand the usefulness of the product and thereby make it more valuable to the user thereby saving money by providing a more versatile catheter." Applicants respectfully disagree. Mische deals with a non-tubular structure where there is absolutely no provision for transporting materials from one end to the other. Thus, the motivation in Mische is to provide for such transportation in the first place, not to provide "another means" as the Examiner has stated.

Conversely, Steen provides a hollow lumen catheter having conventional braid reinforcement. The hollow lumen would provide for material transport or access, and there is no teaching or suggestion whatsoever in Steen that further lumen(s) are necessary or desirable for any purpose.

For these reasons, the Examiner has failed in the burden of providing the necessary motivation for combining references.

Claims 1-9 were further rejected over the combination of Samson '978 and Mische. Applicants also traverse this grounds for rejection.

The Samson patent also describes a braid-reinforced tubular catheter, and some embodiments including two or more coaxially arranged braid-reinforced catheters. Each of the catheters comprises a hollow central lumen available for material transport or other purposes. The Examiner argues that it would have been obvious to substitute the tubular conductors 19 of Mische for the braids of Samson, arguing that the Mische tubes would provide "another means to transport something from one end of the catheter to the other which would expand the usefulness of the product and thereby make it more valuable to the user and thereby save money by providing a more versatile catheter.

Applicants respectfully believe that such an assertion falls far short of the Examiner's burden of identifying motivation in either of the references or in the prior art in general for making the claim combination. Where in Samson is there any suggestion that further lumens are necessary, much less that lumens in the wall of the catheter be provided?

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Conversely, where in Mische is it suggested that the tubular conductors would find use in the wall of an otherwise tubular structure, such as the catheters of Samson? The Examiner's assertion that the combination is more valuable is merely hindsight reconstruction based on the teachings of the present application. The Examiner's further assertion that these structures would save money is mere speculation based on nothing that is of record in this application.

CONCLUSION

For these reasons, Applicants respectfully submit that the obviousness rejections are not supportable and request that they be withdrawn and that the Application be passed to issue at an early date.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (650) 326-2400.

Respectfully submitted,
James M. Heslin
Reg. No. 29,541

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 650-326-2400
Fax: 415-576-0300
Attachment: *Terminal Disclaimer US 6,702,782*
JMH:jis/jke
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